

Attorney Docket No.: DBT006PCTUS1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Georges, et al.

Serial No.: 10/541,640

Filed: July 6, 2005

For: Systems and Methods for Portable Audio Synthesis

Examiner:

Group Art Unit:

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Legal Staff
International Division

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION; DECLARATION OF ALAN R. LOUDERMILK

Dear Commissioner:

In response to the Decision mailed 12 December, 2006 ("Decision"), Applicant hereby submits this request for reconsideration. As this response contains statements of Alan R. Loudermilk, it also is submitted as a supporting declaration for this submission. A petition for extension of time accompanies this submission and is hereby requested.

The Decision refused Applicant's request under Rule 1.497(d) based on an alleged failure to provide the written consent of the assignee. The Decision questioned whether Applicant had furnished a copy of the assignment from the original inventors to the assignee. This submission requests reconsideration because the "Confirmation of Assignment" in fact does establish assignment to the assignee, MediaLab Solutions LLC. Accordingly, Applicant submits that the refusal of the request under Rule 1.497(d) was in error.

Applicant wishes to provide the following supplemental explanation.

As the declaration submitted with this application indicates, the co-inventors for this application include a number of persons who are French citizens (co-inventors Georges, Lafitte, Wenzinger, Laurent, Flohr and Chevreau) and a number of person who are US citizens (Damevski, Blair, Loudermilk). All of the co-inventors were employees and/or consultants of one or more of the MadWaves Entities (Madwaves SARL, dBTech SARL, MadWaves UK). By virtual of their employment and/or consulting arrangements, Applicant

was advised that all such persons were obligated to assign, or had in effect already assigned, rights to inventions made by such persons in their work for the MadWaves Entities, either by way of contract or operation of law governing such employees/consultants (either in France or the US).

Thus, the first paragraph of the Confirmation of Assignment states:

"As an employee of and/or consultant to MadWaves SARL (previously dBTech SARL) and/or MadWaves UK, Ltd. (collectively "MadWaves Entities"), the undersigned persons previously assigned to the MadWaves Entities (or agreed to assign or was obligated to assign to the MadWaves Entities) certain rights that the undersigned persons may have had as inventors/co-inventors with respect to certain inventions made on behalf of the MadWaves Entities."

The foregoing paragraph in the Confirmation of Assignment establishes that each of the co-inventors, by virtual of being "an employee and/or consultant to" the MadWaves Entities, had either assigned or agreed to assign their rights to "certain inventions" to the MadWaves Entities. It should be noted that this paragraph is generic and does not state that the co-inventors has previously signed an assignment for this particular patent application to any party. In fact, the Confirmation of Assignment is known to be the only assignment document signed by the co-inventors that relates to this particular patent filing.

The second paragraph of the Confirmation of Assignment states:

"The MadWaves Entities have entered into one or more agreements with MediaLab Solutions LLC, an Illinois limited liability company having an office at 1550 N. Lake Shore Drive, No. 16C, Chicago, IL 60610 ("MediaLab"), with respect to protecting patent rights previously owned by the MadWaves Entities, which includes the assignment of such patent rights to MediaLab."

This paragraph establishes that the MadWaves Entities had agreed to assign patent rights (including rights to the present application) owned by the MadWaves Entities to MediaLab Solutions. Thus, by agreement between the MadWaves Entities and MediaLab Solutions, the subject patent rights were being assigned to MediaLab Solutions.

The third paragraph of the Confirmation of Assignment states:

Based on the foregoing, the undersigned persons, to the extent that the undersigned individuals are inventors or co-inventors thereof, confirm the assignment of, or assign, to the MadWaves Entities the entire right, title and interest in the inventions set forth in the patent applications and/or patents listed in Exhibit A, including any other applications for patent of any type which may be filed or issued based thereon and the right to collect damages or royalties from the use thereof ("Assigned Patent Filings").

This paragraph states that each of the co-inventors confirm that they had previously assigned rights to the Assigned Patent Filings (such as by operation of French law), or (by execution of the Confirmation of Assignment) were "assign[ing]" the Assigned Patent Filings

to the MadWaves Entities. This paragraph was written to accommodate both possibilities: (1) by operation of law or otherwise under whatever employment and/or consulting arrangement the individual may have had with the MadWaves Entities, each co-inventor had already signed rights to inventions made by the co-inventor to the MadWaves Entities (and the Confirmation of Assignment serves to "confirm the assignment of" such rights to the MadWaves Entities); or (2) the co-inventor had not yet assigned rights to inventions made by the co-inventor to the MadWaves Entities, and in such event the co-inventor was intending to "assign" such rights to the MadWaves Entities. In either case, the signature of the co-inventors was confirming or establishing that the MadWaves Entities owned whatever rights the co-inventors may have had in the Assigned Patent Filings.

The fourth paragraph of the Confirmation of Assignment states:

"The MadWaves Entities assign, and/or confirm the assignment, to MediaLab of the Assigned Patent Filings."

This paragraph simply confirms that whatever rights the MadWaves Entities may have had in the Assignment Patent Filings were assigned to MediaLab Solutions. Thus, all rights to the present application, previously owned by the MadWaves Entities, were expressly and unambiguously assigned to MediaLab Solutions.

The Decision, however, seems to misunderstand the statement at the bottom of the Confirmation of Assignment, which states "MediaLab Solutions hereby agrees that the patent rights assigned by Voislav Damevski shall not be assignable to the MadWaves Entities without Mr. Damevski's prior written consent." This sentence by its express terms contemplates that MediaLab Solutions owns the Assigned Patent Patents and that MediaLab Solutions will not re-assign the rights assigned by Mr. Damevski back to the MadWaves Entities without Mr. Damevski's consent. It does not state that further written consent of Mr. Damevski is required for the assignment to MediaLab Solutions. The present assignee is MediaLab Solutions; Mr. Damevski's signature (as well as the other signatures) confirms that all rights to the Assigned Patent Filings were assigned to MediaLab Solutions. The statement at the bottom is a further agreement by MediaLab Solutions that it will not subsequently assign any of the rights assigned by Mr. Damevski back to the MadWaves Entities without Mr. Damevski's prior written consent. It should be noted that, at the time, there were contractual issues unrelated to the current application between the MadWaves Entities and Mr. Damevski. Thus, Mr. Damevski desired that MediaLab Solutions not assign any rights

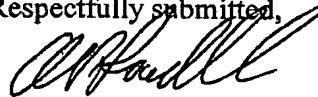
previously owned by Mr. Damevski back to the MadWaves Entities without his consent. This statement does not in any way contradict that the current assignee, MediaLab Solutions, owns all right, title and interest in the present application.

Based on the foregoing, Applicant requests reconsideration. The Confirmation of Assignment, properly read, clearly establishes that MediaLab Solutions is in fact the assignee of the present application. Thus, all requirements for a request under Rule 1.497(d) were met by Applicant's previous submission. Applicant submits that the refusal of Applicant's request under Rule 1.497(d) was in error and should be withdrawn.

If there are any questions or issues regarding this application or this submission, Applicant's attorney requests an opportunity to discuss such questions and/or issues and if necessary submit additional materials in order to resolve any outstanding matters. Please charge any additional fees due, or credit any overpayment, to Deposit Account No. 50-0251.

The undersigned declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,



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February 15, 2007
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I hereby certify that the foregoing is being mailed to being faxed to the Office of PCT Legal Administration via fax number 571-273-0459, on the date indicated above.

